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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/511,443	02/23/2000	Megumi Kamimura	21778.04100	3313

7590 12/17/2004

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/511,443

Applicant(s)

KAMIMURA, MEGUMI

Examiner

Thai Tran

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Please include the new Art Unit 2616 in the caption or heading of any written or facsimile communication submitted after this Office Action because the Examiner, who was assigned to Art Unit 2615, will be assigned to new Art Unit 2616. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Oct. 22, 2004 has been entered.

Response to Arguments

3. Applicant's arguments filed Oct. 22, 2004 have been fully considered but they are not persuasive.

In re page 9, applicant argues that the cited prior art of record fails to disclose storing not only the starting address, but also the serial number of the selected source data.

In response, the examiner respectfully disagrees. Robell et al discloses in page 8, lines 4-12 that "The steps performed by the computer in the play program subroutine are shown in FIGURE 4B. Beginning with a step 180, the computer analyzes the

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program definition including **an identification number of the program**, a title of the program, the program play type (either continuous or sequential), the maximum play time of the program (in minutes), the song play type (either sequential or random), and the list of audio files to be played including **the identification number that identifies the corresponding compressed audio file**, the title, and artist. In addition, a timer within the computer system that marks the playing time of the program is started". From the above passage, the identification number of the program of Robell et al anticipates the claimed "starting address" because the identification number is used to identifies the corresponding compressed audio file. Robell et al also discloses in page 6, lines 13-19 that "FIGURE 2 illustrates the data that is recorded on the CD-ROM 22. At the beginning of the CD-ROM is a file that contains a computer program 90 that operates a CD-ROM player that plays the CD-ROM. Following the computer program 90 is a playlist 92 that identifies the version number of the program, **an identification number of the CD-ROM**, a title of the CD-ROM, the number of programs stored on the CD-ROM (presently between one and four), and the number of compressed music/audio files that are stored on the CD-ROM". Robell et al teaches an identification number of the CD-ROM and the new cited reference, Sako et al (US 6,215,745) teaches the CD-ROM identification can be serial numbers (col. 12, lines 30-31). When Robell et al and Sako et al are combined as proposed by the Examiner, the claimed Serial No. is anticipated by the serial no. of Sako et al.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robell et al (WO 98/48532) in view of Chan et al (US 6,711,631 B1) as set forth in paragraph #3 of the last Final Office action.

Regarding claim 1, Robell et al, as discussed in the last Final Office Action, discloses a method of creating contents (Fig. 1) comprising the steps of:

inputting (74 and 76 of Fig. 1, page 5, lines 19-21) first contents information concerning an audio input source or a video input source or an audio and video source;

compressing a signal of said input source according to the need (78 and 70 of Fig. 1, page 5, lines 21-33);

recording a compressed signal of said input source on a recording medium 20 and 22 of Fig. 1, page 4, line 29 to page 5, line 2);

designating recording position information useful for recording the compressed signal of said input source on said recording medium (page 6, lines 13-30), wherein said recording position information is a starting address of the CD-ROM (a unique identification number that identifies a computer file containing a compressed recording of the song, page 4, lines 29-35);

creating a table containing at least more than one second contents information concerning a predetermined input source in which said recording position information is

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added to said first contents information concerning input source (page 4, lines 4-13 and page 6, lines 13-30); and

recording said table on said recording medium (page 6, lines 13-30). However, Robell et al does not specifically disclose the newly added limitation that the recording position information is a starting address of a personal computer card or a DVD RAM or a hard disk drive).

Chan et al teaches that compute 100 permits a user to readily interchange a CD-ROM drive for some other device such as a hard disk drive or conversely (col. 8, lines 11-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the hard disk drive as taught by Chan et al into Robell et al's system in order to increase the storage capacity of the system because hard disk drive has larger storage capacity than CD-ROM.

Regarding claim 2, Robell et al further discloses the claimed wherein said input source signal is compressed in accordance with an MPEG standard (page 5, lines 29-33).

Regarding claim 3, Robell et al discloses the claimed wherein said first contents information contains at least titles of input sources, reproduction times of titles and priority information based on the situation in which the input sources had been used (page 4, lines 1-13 and page 6, lines 20-26).

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Regarding claim 4, Robell et al discloses the claimed wherein said table is recorded on a starting portion of a recording portion on which the compressed signal of said input source was recorded (page 6, lines 13-30).

Apparatus claims 5-8 are rejected for the same reasons as discussed in method claims 1-4 above.

Recording medium claims 9-12 are rejected for the same reasons as discussed in method claims 1-4 above.

Regarding claim 13, Robell et al, as discussed in the last Office Action, discloses a method of downloading compressed data and a first table from a first recording medium on which compressed data of an audio input source or a video input source of an audio and video input source and said first table indicating first contents information containing reproducing position information concerning said input source are recorded on a second recording medium (Fig. 1), a method of downloading contents comprising the steps of:

downloading said first table from said first table (page 4, lines 1-13 and page 6, lines 13-26);

reading out compressed data of a predetermined input source from said first recording medium based on the reproducing position information of said first contents information concerning a predetermined input source on said first table and downloading the compressed data thus read to said second recording medium (page 6, lines 3-30), wherein said recording position information is a starting address of a CD-ROM (the play list comprises a series of data including the version number of the

program being operated, an ID number of the CD-ROM, a title of the CD-ROM, the number of audio programs stored on the CD-ROM, the number of compressed audio files that are stored on the CD-ROM, page 7, lines 17-27);

memorizing recording position information useful for recording said compressed data on said second recording medium (page 4, lines 1-13 and page 6, lines 3-30);

creating a second table containing at least more than one second contents information in which reproducing position information in said first contents information concerning said predetermined input information is replaced with recording position information useful for recording on said second recording medium (page 4, lines 1-13 and page 6, lines 13-26); and

recording said second table on a second recording medium (page 6, lines 13-26). However, Robell et al does not specifically disclose the newly added limitation that the recording position information is a starting address of a personal computer card or a DVD RAM or a hard disk drive).

Chan et al teaches that compute 100 permits a user to readily interchange a CD-ROM drive for some other device such as a hard disk drive or conversely (col. 8, lines 11-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the hard disk drive as taught by Chan et al into Robell et al's system in order to increase the storage capacity of the system because hard disk drive has larger storage capacity than CD-ROM.

Claims 14-16 are rejected for the same reasons as discussed in claims 2-4 above.

Apparatus claims 17-20 are rejected for the same reasons as discussed in claims 13-16.

6. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robell et al (WO 98/48532) in view of Sako et al (US 6,215,745).

Regarding claim 21, Robell et al discloses a method of storing digital data (Fig. 1) comprising:

inputting (74 and 76 of Fig. 1, page 5, lines 19-21) contents information to a recording apparatus;

automatically providing a recording start address of the contents information (page 6, lines 13-30, a unique identification number that identifies a computer file containing a compressed recording of the song, page 4, lines 29-35);

compressing data of the selected source if desired (78 and 70 of Fig. 1, page 5, lines 21-33);

recording the data of the selected source on a recording medium (20 and 22 of Fig. 1, page 4, line 29 to page 5, line 2);

creating a contents information table, once all the selected source data is stored on the recording medium (page 4, lines 4-13 and page 6, lines 13-30);

creating a table containing at least more than one second contents information concerning a predetermined input source in which said recording position information is

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added to said first contents information concerning input source (page 4, lines 4-13 and page 6, lines 13-30);

setting a start address portion of each source data on the recording medium as part of the contents information table (page 4, lines 4-13 and page 6, lines 13-30); and

storing the contents information table on the recording medium (page 6, lines 13-30). However, Robell et al does not specifically disclose the step of automatically providing a serial number of a selected source from the recording apparatus.

Sako et al teaches that serial numbers can be used as medium identification (col. 12, lines 28-34.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the serial numbers as taught by Sako et al into Robell et al's system in order to simplify the process of managing CD-ROMs by assigning each CD-ROMs a unique serial number.

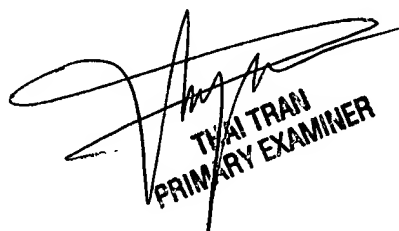
Apparatus claim 22 is rejected for the same reasons as discussed in corresponding method claim 21.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN
PRIMARY EXAMINER